



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

09/890,685

01/18/2002

Guido Dedenbach

521.1008

6709

23280

7590

02/12/2004

DAVIDSON, DAVIDSON & KAPPEL, LLC
485 SEVENTH AVENUE, 14TH FLOOR
NEW YORK, NY 10018

EXAMINER

DONOVAN, LINCOLN D

ART UNIT

PAPER NUMBER

2832

DATE MAILED: 02/12/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Applicati n No.

09/890,685

Applicant(s)

DEDENBACH ET AL.

Examin r

Lincoln Donovan

Art Unit

2832

AW

-- The MAILING DATE of this communication appears n the cover sheet with the corresp ndence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 November 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 8-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 8-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 8 and 10-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Claims rejected under 35 U.S.C. 103(a) as being unpatentable over EPO 0560696 in view of Chien et al. (US 5,196,8152).

EPO 0560696 disclose a circuit breaker (figure 1) comprising:

- an interrupter chamber housing (10) having an outside wall of a plastic material;
- an interrupter including a pair of u-shaped stationary contacts (24, 25)

embedded within the interrupter chamber;

- a rotary pivotal movable contact member (44') movably connected with at least one of the stationary contacts;

- a magnetic member (33) connected in the leg connection portion of the stationary contacts; and

- first and second contact pads (figure 2) connected with the stationary terminals.

EPO 0560696 discloses the instant claimed invention except for: the bus bar being force fit within the outside wall and the use of a bus bar with the stationary contacts.

Chien et al. discloses a bus bar (figure 1) force fit within a housing shell portion.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to use force fit terminal design of Chien et al. into the outside wall of EPO 0560696 for the purpose of facilitating assembly and/or replacement.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide a bus bar type connection for the stationary contacts of EPO 0560696, as modified, for the purpose of enabling mounting within a bus type box.

Claims 9 and 16-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over EPO 0560696 in view of Chien et al., as applied to claim 8 above, and further in view of Stieglitz (US 5,428,8831).

EPO 0560696, as modified, disclose the instant claimed invention except for: the stationary contact assembly being injection molded within the outside wall.

Stieglitz discloses a contact member (17) being molded within a casing of a electromagnetic control apparatus.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to use an injection molding process for the contact assembly of EPO 0560696, as modified, for the purpose rigidly supporting the contact and magnet structure within the housing and simplifying construction.

The claimed method steps would have been inherent in the product structure.

Response to Arguments

Applicant's arguments filed 11-20-03 have been fully considered but they are not persuasive.

Applicant argues:

[1]: There is no motivation to combine Chien et al. with EPO 050696.

[2]: Neither Chien et al. or EPO 050696 are directed towards dissipating heat generated by the bus bars.

[3]: Examiner uses impermissible hindsight to combine Chien et al. with EPO 050696.

[4]: Stieglitz does not teach or suggest the injection molding features of claims 9 and 16.

[5]: Stieglitz is non-analogous to the circuit breaker art.

[6]: There is no motivation to use the injection molding technique of Stieglitz with EPO 050696.

Examiner disagrees.

Regarding [1]: In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, a skilled artisan would have been motivated to use the bus bar mounting design of Chien et al. for the bus bar of EPO 050696 in order to position and retain the bus bar within the housing.

Regarding [2]: Applicant has not claimed, nor has examiner considered, any specific structure to dissipate heat from the bus bar.

Regarding [3]: In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Regarding [4]: Applicant claims molding the material around the contact. Applicant has not claimed any specific method steps not necessitated by the product structure.

Regarding [5-6]: In response to applicant's argument that Stieglitz is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, applicant's claimed invention is directed towards terminal mounting in a plastic case. Stieglitz discloses molding a terminal within a plastic case. A skilled artisan would have been motivated to use the terminal mounting teach of Stieglitz in alternate terminal mounting applications to mount and secure the terminal.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lincoln Donovan whose telephone number is (571) 272-1988. The examiner can normally be reached on M-F 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Elvin Enad can be reached on (571) 272-1990. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 2832

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Idd
2/6/04


LINCOLN DONOVAN
PRIMARY EXAMINER
GROUP 2100